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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,288	11/28/2000	Rudolf Ritter	PM275385	8925

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,288

Applicant(s)

RITTER ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Preliminary Amendment

1. Applicant's submission of a preliminary amendment on November 28, 2000 is acknowledged. It is noted that applicant amended claims 3-5, and 8 to eliminate the multiple dependencies. It is noted that claims 9 and 10 also include multiple dependencies but were not amended.

Applicant's submission of an amendment to the drawings on November 28, 2000 is acknowledged and approved for entry.

Claim Objections

2. Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). In this case, claim 10 depends from multiple dependent claim 9. Accordingly, the claim has not been further treated on the merits. If Applicant amends claim 10 to be in singular dependent form, the objection will be withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 18-20, Applicant claims, "at least one service point identification, the payment terminal identification, and the total transaction amount", wherein it is unclear what is meant by "at least one". Does Applicant intend to claim a payment request comprising each of the three listed items (service point ID, payment terminal ID, and amount) or does Applicant intent to require at least one of the three? For purposes of the examination, the Examiner assumes that Applicant's claim requires all three items, wherein there is at least one service point identification. Clarification is required. Claim 6 suffers from the same problem. Applicant is requested to clarify the claim language for both claims 1 and 6.

In claim 1, line 20, "the contactless device interface (21)" lacks proper antecedent basis. It is noted that a separate element with the same name "a contactless device interface (11)" is noted in the case but can not provide proper antecedent basis since they are entirely different elements as indicated by unique reference numbers 11 and 21. The Examiner recommends modifying the reference name for each element to be more descriptive of the location of the claimed contactless device interface. For example, the Examiner recommends referring to "the contactless device interface (11)" as --the mobile contactless device interface" and referring to "the contactless device interface (21)" as the --the terminal contactless device interface". Correction is required.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1, 2, 4, 6, 7, and 9/6, 9/7 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 98/34203 (WO '203) in view of International Publication No. WO 98/37524 (WO '524).

In regards to independent **claim 1**, WO '203 discloses a payment transaction method between a customer with a portal mobile device (412, see Figure 8) and a service point, in which payment transaction method a payment terminal (414) of the service point determines a total transaction (see last paragraph of page 11) to be paid and a transaction identification assigned to the total amount (see Figure 6, 200), and informs the customer about the total transaction amount (see last paragraph of page 11) and the transaction identification (200), and in which payment transaction method the customer enters the transaction identification into the mobile device (at least passively by allowing transaction ID to be sent to mobile unit), wherein the payment terminal (414), during determination of the transaction identification, the mobile device (412) transmits, via a mobile contactless device interface (424, IR or RF as set forth in the abstract), the transaction identification (via step 202 in Figure 6), entered by the customer (at least passively as set forth above), to the payment terminal (414); the payment terminal (414), after receipt of the transaction identification, transmits a payment request (200) which comprises at least one service point (inherent) and total transaction amount (inherent), via a terminal

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contactless device interface (426) to the mobile device; in the mobile device (412) a payment record is prepared, which contains a linking of payment request to a customer identification (inherent in authorization of step 202) of the customer, and is transmitted (step 202) from the mobile device (412) via the mobile contactless device interface (424) to the payment terminal (414); **[claim 2]** during the transmission of the transaction identification, entered by the customer, from the mobile device (412) to the payment terminal (414) a sender identification is co-transmitted (it is inherent during a transaction that a transmission will provide identification of the sender), and wherein the payment terminal (414) transmits payment request to the mobile device (412) established through the sender identification; and **[claim 4]** in the mobile device (412) data about the type of payment are added to the payment record before transmission of the payment record to the payment terminal.

In regards to independent **claim 6**, WO' 203 discloses a payment transaction system comprising a plurality of portable mobile device (412, inherent that the system utilizes more than one device) and a plurality of payment terminals (414, inherent that the system utilizes more than one terminal) at a service point, which mobile devices (412) and payment terminals (414) each comprise at least one processor (inherent) and one contactless device interface (424, 426) via which contactless device interface (424) the mobile devices (412) can communicate with the payment terminals (414), which payment terminals (414) each comprise means of informing a customer about a total transaction amount to be paid of a payment transaction and a transaction identification assigned to the payment transaction (see step 200 in Figure 6), which payment terminals (2) each comprise a transaction identification module which transaction module in each case determines the transaction identification for a payment transaction, which mobile devices

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(412) each comprise a transaction response module (see step 202 in Figure 6), which transaction response module receives a transaction identification entered by a customer (at least passively by allowing transaction ID to be sent to mobile unit) by means of operating elements of the respective mobile device (412) and transmits it via the contactless device interface (424) to the payment terminal (414); which payment terminals (414) each comprise a payment request module, which payment request module, after receipt of a transaction identification from a mobile device (412), transmits a payment request, comprising at least one service point identification (inherent) and the total transaction amount of the payment transaction, determined through the received transaction identification, via the contactless device (426) to the mobile device (412) from which the transaction identification was received, and which mobile devices (412) each comprise a payment record module which payment record module prepares a payment record comprising a payment request (202), received by the mobile device (412) from a payment terminal (414), and a customer identification of the respective customer, and transmits the prepared payment record via the contactless device (424) to the payment terminal from which the payment request was received; **[claim 7]** the mobile devices (412) each comprise means to co-transmit a sender identification (it is inherent that sender identification is sent such that the payment terminal can identify the customer) when transmitting the transaction identification, entered by the customer, to the payment terminal (414) and wherein the payment request module comprises means to transmit the payment request to the mobile device (412) determined through the sender identification; **[claim 9]** the payment record module comprises means to add to the payment record data on the type of payment (see Figure 3) before transmission of the payment record to a payment terminal (414).

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WO '203 discloses wireless communication between the mobile unit and the payment terminal put fail to expressly indicate that use of a payment terminal identification. It is noted that

In regard to both claims 1 and 6, WO '203 fails to expressly disclose utilizing a payment terminal identification to identify the respective terminal.

WO '524 teaches the use of a payment terminal identification (see ABSTRACT) to identify the respective cash register.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203 with the terminal ID as taught by WO '524, because a terminal ID allows location and communication between a plurality of devices.

7. Claims 3, 8, and 9/8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '203 in view of '524 in view of Official Notice.

WO '203 in combination with WO '524 fail to expressly disclose increasing wireless transmitting power between the two communication interfaces. The Examiner takes Official Notice that it is old and well known to increase transmitting power between two communication devices when contact is not originally available.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203's modified device with transmission power increase as is well known in the art, because increasing transmission power will increase the overall range of communication between the two devices and thereby improve overall operation of the communication system.

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8. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '203 in view of WO '524 as applied to claim 1 above, and further in view of U.S. Patent No. 6,016,476 (Maes et al.).

WO '203 in combination with WO '524 show all the claimed elements as set forth above except for the use of a biometrics feature for identifying a user.

Maes et al. teaches the use of a biometrics feature for identifying a user during an electronic transaction (see sensor 40 in column 5, lines 54-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203's modified device with a biometric sensor as taught by Maes et al., because a biometric sensor provides a secure means of identifying the user, wherein reducing the likelihood of an improper transaction.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

LaBounty is cited of interest for disclosing a method for transmitting financial data.

Shimizu et al. is cited of interest for disclosing a self-scanning POS system.

Tracey et al. is cited of interest for disclosing a portable data terminal for shopping.

Forslund et al. is cited of interest for disclosing a smart wallet using wireless communication.

Makipaa et al. is cited of interest for disclosing a system for collecting financial data.

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Heinonen et al. is cited of interest for disclosing a method of using a portable device to make electronic wireless payments.

Emmof et al. is cited of interest for disclosing a portable communication device for purchase items using biometric identification.

Soini et al. is cited of interest for disclosing a multi-service mobile station.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

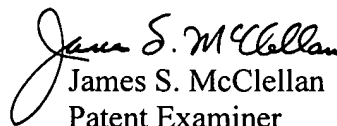
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


James S. McClellan
Patent Examiner
A.U. 3627

jsm; March 31, 2003